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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,400	07/15/2003	Joe F. Wells	5823-70103	9550

23643 7590 07/12/2004

BARNES & THORNBURG  
11 SOUTH MERIDIAN  
INDIANAPOLIS, IN 46204

EXAMINER
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TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/620,400	WELLS, JOE F.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thanh K Truong	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed structures recited in claims 19 and 20 (first default position and second position of the pneumatic valves) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 is a dependent claim of claim 1, and claim 1 claims an apparatus that is pneumatically operated, however, claim 2 further claims that the device of claim 1 is manually operated. The applicant's disclosure provides no support for a device that is interchangeable from pneumatically operated to manually operated. Similarly, claim 11 (also a dependent claim of claims 9, 8, 7 and 1) recites the structure of a manually operated device.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed above in paragraph 2 of this office action, from the applicant's disclosure, the pneumatically operated device and the manually operated device are not

interchangeable. In other words, one cannot convert the presently claimed pneumatically operated device into the manually operated device. Therefore, it is unclear how claims 2 and 11 are able to be properly claimed claim 1 as the dependent claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 6, 7, 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyer (4,627,563).

Mayer discloses an apparatus comprising: a pneumatic actuator 50; a fastener holder 130 configured to hold a plurality of fasteners 160; a fastener pusher 76 coupled for movement relative to the fastener holder, the fastener pusher being configured to engage an end of a fastener (figure 3); an actuator 50 coupled to the fastener pusher, the actuator being configured to move the fastener pusher between an extended fastener-inserting position (figure 5) and a retracted position (figure 2).

Mayer further discloses: charging chamber 52; and a control apparatus 90 including a pneumatic valve.

8. Claims 1, 6-10, 12-14, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange (3,929,056).

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Lange discloses a fastener insertion device 1 for inserting fasteners in a substrate, the device comprising: a pneumatic actuator 4, 5; a fastener holder 7 configured to hold a plurality of fasteners (column 2, lines 28-29 & lines 35-36); a fastener pusher 6 coupled for movement relative to the fastener holder, the fastener pusher being configured to engage an end of a fastener (figure 1 & lines 35-38); an actuator 4, 5 coupled to the fastener pusher, the actuator being configured to move the fastener pusher between an extended fastener-inserting position and a retracted position.

Lange further discloses: charging chamber 3; a control apparatus for controlling the actuator and the control apparatus including two pneumatic valves 14, 15; wherein both valves must be actuated in order to move a plunger in the pneumatic cylinder (figure 4 & column 3, lines 20-34); wherein the two pneumatic valves have a first default position and a second position, the actuator is actuated when the two pneumatic valves are in their second position (figures 1-4); wherein compressed air biases the plunger in the uppermost position (figure 1); a second actuator 14 including a handle 2 and an operator-driven piston 16 coupled to the handle (figures 1-4).

9. Claims 2 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Koester et al. (5,025,969).

As discussed above in paragraphs 3 and 5 of this office action, claims 2 and 11 are not properly claimed as the dependent claims (of claim 1), and thus being treated as the independent claims.

Koester discloses a fastener insertion device that is manually operated (figure 1) comprising: manually operated actuator 96; a spring 106 for biasing the plunger 102 in the uppermost position.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (4,627,563) in view of Massari, Jr. et al. (4,688,710).

As discussed above in paragraph 8 of this office action, Meyer discloses the claimed invention, but does not expressly disclose that the magazine are removably attached to the device.

Massari discloses (figure 1) an apparatus comprises magazine for staples and stakes and the magazine is configured to be removably attached to the device providing a quick and easy interchangeable magazine (column 1, lines 66-68). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Meyer's apparatus by incorporating the interchangeable magazines as taught by Massari provides the device with a quick and easy means to interchange the magazines.

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12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (4,627,563) in view of Chou (4,815,647).

As discussed above in paragraph 8 of this office action, Meyer discloses the claimed invention, but does not expressly disclose that the stake magazine is configured to house stakes of different dimensions.

Chou discloses (figure 2) an apparatus comprises stake magazine M, and the magazine is configured to house stakes of different dimensions provides a magazine that could accommodating stakes of different types with no need of any adjustment (column 1, lines 50-52). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Meyer's apparatus by incorporating the magazine as taught by Chou for providing a device with a magazine that could accommodating stakes of different types with no need of any adjustment.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (703) 605-0423. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

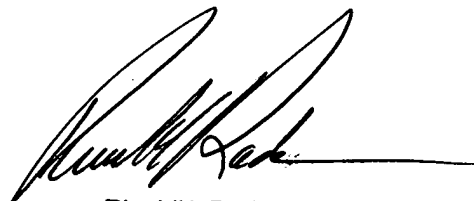


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkf  
June 29, 2004.



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700